REMARKS

This Application has been reviewed carefully in light of the Final Office Action mailed March 24, 2006 ("*Office Action*"). Claims 1-17 were pending in the Application, and the Examiner rejects all pending claims. Applicant respectfully requests reconsideration and favorable action in this case.

I.   Section 101 Rejections: Claims 1-6 and 11-15 are Directed to Statutory Subject Matter.

The Examiner rejects Claims 1-6 and 11-15 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant appreciates the Examiner's consideration of and response to Applicant's previously submitted arguments. However, Applicant maintains that Claims 1-6 and 11-15 are, in fact, directed to statutory subject matter.

The *Office Action* states, "Claims 1 and 11 are not limited to tangible embodiments. In view of Applicant's disclosure, the medium is not limited to tangible embodiments nor does the disclosure state what a computer-readable medium could be." *Office Action*, p. 2. Applicant first submits that Claims 1 and 11 are method claims that do not recite or identify a "computer-readable medium." Applicant requests clarification of this portion of the Examiner's argument.

Second, Applicant respectfully submits that Claims 1 and 11 need not be "limited to tangible embodiments." Section 101 specifically identifies process claims as patentable subject matter: "As cast, 35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter." M.P.E.P. § 2106 (emphasis added). The Manual of Patent Examining Procedure goes on to explain when processes may be non-statutory subject matter:

> In practical terms, claims define nonstatutory processes if they:
> - consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or
> - simply manipulate abstract ideas, e.g., a bid (*Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (*Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application.

M.P.E.P. § 2106 (*see* section IV.B.1) (emphasis added). Applicant respectfully submits that neither Claim 1 nor Claim 11 consists solely of mathematical operations or simply manipulates abstract ideas.

Thus, Applicant respectfully submits that independent Claims 1 and 11 are directed to statutory subject matter. Because independent Claims 1 and 11 are directed to statutory subject matter, Applicant respectfully requests reconsideration and allowance of Claims 1 and 11 and their respective dependent claims.

II.   Drawing Objections: The Drawings Show Every Feature of the Claims.

The Examiner objects to the drawings under 37 C.F.R. §1.83(a). In particular, the *Office Action* asserts that the "function portions" are not shown by the drawings. *Office Action*, p. 2. Applicant respectfully disagrees. Applicant's previously submitted arguments (*see* Applicant's Appeal Brief filed May 9, 2005) are repeated below.

Branch module 26 and action modules 31 and 32 of Figure 1 illustrate one example of "function portions." As discussed in the specification at lines 3-21 of page 15:

> The project definition 14 in FIGURE 1 is a simple example, but has been configured to show at least one example of each of the four types of modules that are recognized in the disclosed embodiments of the present invention. In other words, the disclosed embodiments of the present invention recognize source modules, one example of which appears at 21, branch modules, one example of which appears at 26, action modules, two examples of which appear at 31 and 32, and destination modules, two examples of which appear at 37 and 38. As reflected by the brackets along the bottom of FIGURE 1, branch modules and action modules are sometimes referred to collectively herein as function modules. Source modules deal with the question of where to find the data to be processed, branch modules deal with the question of which data should and should not be processed in a specified manner, action modules deal with the question of what processing should be performed on the data, and destination modules deal with the question of where to put the processed data.

Thus, Applicant submits that the drawings, without correction, show at least one embodiment of "function portions."

Also, the *Office Action* states: "The drawings must show every feature of the invention specified in the claims." *Office Action*, p. 2. The implication that the drawings should disclose more than examples runs afoul of settled case law. The specification, including the drawings, need not be a production specification detailing every conceivable

embodiment of the claimed invention. *See, e.g., Koito Mfc. Co. v. Turn-Key-Tech LLC*, 381 F.3d 1142, 1155-56 (Fed. Cir. 2004). Rather, providing specific embodiments contemplated by the inventors satisfies the requirements of § 112. *See, e.g., Cordis Corp. v. Medtronic, Inc.*, 339 F.3d 1352, 1365 (Fed. Cir. 2003) (a patentee is not required to describe in the specification every conceivable and possible future embodiment of his invention).

Finally, Applicant respectfully disagrees with the *Office Action*'s statement that the definition of "trigger" is limited to the portion of the specification that was cited by Applicant as describing one embodiment of a trigger. *See Office Action*, p. 8. Applicant submits that the claim terms should take their plain, ordinary meaning, given their context, as would be attributed by one of ordinary skill in the art.

Because the drawings show at least one embodiment of all aspects of the claims, Applicant respectfully submits that the drawings comply with all requirements. Applicant respectfully requests reconsideration and withdrawal of the objection to the drawings.

III. Section 103 Rejections: Claims 1-17 Are Patentable Over the References Because the Combination is Improper and the Combination Fails to Teach or Suggest All Elements of the Claims.

The Examiner rejects Claims 1-17 under 35 U.S.C. 103(a) as unpatentable over the combination of U.S. Patent No. 6,654,795 to Coile ("*Coile*"), U.S. Patent No. 6,333,752 to Hasegawa et al. ("*Hasegawa*"), U.S. Patent No. 6,202,070 to Nguyen et al. ("*Nguyen*"), and U.S. Patent No. 6,441,913 to Anabuki et al. ("*Anabuki*"). First, Applicant respectfully submits that the proposed *Coile-Hasegawa-Nguyen-Anabuki* combination fails to teach or suggest all elements of the claims. Secondly, Applicant maintains that there is no suggestion or motivation in the cited references or in the prior art to combine *Coile, Hasegawa, Nguyen,* and *Anabuki*.

A. The proposed *Coile-Hasegawa-Nguyen-Anabuki* combination fails to teach or suggest all elements of the claims.

Consider Applicant's independent Claim 1, which recites:

> A method, comprising the steps of:
> providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for manipulating image data;

storing a project definition that is operable when executed to process said image data and includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

displaying a project window that includes a graphical representation of said project definition;

allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

automatically initiating execution of said project definition in response to a change to said image data in said data source;

wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

Applicant appreciates the Examiner's consideration of and response to Applicant's previously submitted arguments. In response to the Examiner's comments, Applicant more fully explains why the proposed combination fails to teach or suggest: (1) displaying a project window that includes a graphical representation of the project definition and (2) automatically initiating execution of said project definition in response to a change to said image data in said data source.

1.   The references fail to teach or suggest displaying a project window that includes a graphical representation of said project definition.

Claim 1 requires "displaying a project window that includes a graphical representation of said project definition." The *Coile-Hasegawa-Nguyen-Anabuki* combination fails to teach or suggest these claimed aspects.

As teaching these claimed aspects, the *Office Action* points to *Hasegawa*, Figures 5-9 and column 33, lines 8-35. *Office Action*, p. 5. Also, in response to Applicant's previously submitted arguments, the *Office Action* states:

> Examiner would like to draw the Applicant's attention to the above interpretation of "project definition" which stems from the Applicant's specification. In light of the definition and the prior art of Hasegawa, the project window, which has multiple images, are each modified differently as

the result of what the "project definitions" have done the images, (a "project definition" is how data from a file should be processed" or has interpreted how the data from the file was processed). Therefore, the "project definition" can be displayed, because it is how the image files are processed.

Office Action, p. 11-12. However, Applicant respectfully submits that *Hasegawa* fails to teach or suggest displaying a graphical representation of the claimed project definition in part because the project definition includes a plurality of function portions which each define at least one input port and at least one output port.

Hasegawa's display screens (Figures 5-9) show different versions of an image: a reference image and modified images that show the effects of different combinations of parameters on the reference image. *See Hasegawa*, col. 2, line 62 – col. 3, line 8 & Figure 9. Thus, even assuming, for the sake of argument, that *Hasegawa* teaches or suggests the claimed project definition, the cited *Hasegawa* display screens would be only graphical representations of the <u>effects</u> of executing the project definition, rather than of the project definition itself.

Moreover, Applicant notes that Claim 1 requires "a project definition . . . [to] include[]: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition." The cited portions of *Hasegawa* do not teach or suggest a project definition that includes a plurality of function portions which each define at least one input port and at least one output port, much less displaying this claimed project definition.

Finally, in response to Applicant's previously submitted arguments, the *Office Action* states that "[t]aking an action such as saving or manipulating an image is not novel and is commonly done in the art whether it is an image, text or any data." *Office Action*, pg. 11. To the extent this statement constitutes Official Notice, Applicant respectfully traverses and requests the Examiner to provide objective evidence of this assertion.

Anabuki fails to remedy the deficiencies of *Hasegawa*. Moreover, neither *Coile* nor *Nguyen* deal with the processing of image data. Thus, none of these references teach or suggest the displayed project window that includes a graphical representation of the claimed project definition.

Applicant thus respectfully submits that *Coile, Hasegawa, Nguyen,* and *Anabuki,* whether taken alone or in combination, fail to teach or suggest every element of Claim 1.

Likewise, independent Claims 7, 11, and 16 include limitations that, for substantially similar reasons, are not taught or suggested by the references. Because *Coile, Hasegawa, Nguyen,* and *Anabuki,* whether taken alone or in combination, fail to teach or suggest every element of independent Claims 1, 7, 11, and 16, Applicant respectfully requests reconsideration and allowance of Claims 1, 7, 11, and 16, and their respective dependent claims.

2.   The references fail to teach or suggest automatically initiating execution of the project definition in response to a change to the image data in the data source.

Claim 1 also requires "automatically initiating execution of said project definition in response to a change to said image data in said data source." The *Coile-Hasegawa-Nguyen-Anabuki* combination fails to teach or suggest these claimed aspects.

As teaching these claimed aspects, the *Office Action* points to a discussion in *Nguyen* of automatic database triggers. *Office Action,* p. 5. In response to Applicant's previously presented arguments, the *Office Action* states:

> [These claimed aspects do] not have what the "change" could or would be. All that is stated is that there is a "change" which could be change in location, image type, (gif to jpeg), size, color or any attribute. Now since the main definition of a "project definition" is how data from a file should be processed, could make one interpret once an attribute is desired to change, i.e., changing from gif to a jpeg, once it is selected and a Save button is executed that would active the "project definition" save the data as a new type. [sic]

Office Action, p. 11. However, even assuming, for the sake of argument, that these statements are accurate, the combination still fails to teach or suggest the claimed aspects because Claim 1 requires, <u>in response to a change to said image data in said data source,</u> automatically initiating execution of the project definition. *Nguyen*'s generic database triggers fail to teach or suggest these claimed aspects.

The *Office Action* later states that "because the claim language is silent on what constitutes a 'change' or what type of execution [] said 'project definition' could be doing[,] the prior art in combination teaches the claim language." *Office Action,* p. 14. However, Applicant submits that these claimed aspects require a particular type of operation that works in conjunction with other elements of the claim. Claim 1 requires "a change <u>to said image data in said data source</u>" and a project definition including "a plurality of function portions . .

14

. which each define at least one input port and at least one output port." The proposed combination fails to teach or suggest these claimed aspects.

Additionally, as noted previously by Applicant, *Nguyen* teaches away from the combination. The cited portion of *Nguyen* discusses deficiencies of the prior art: "While convenient, [database triggers] can also increase the overhead consumed by a DBMS." *Nguyen*, col. 4, lines 12-13. *Nguyen* continues by stating that the invention of *Nguyen* seeks to overcome this and other deficiencies. *Nguyen*, col. 4, lines 26-33. When one reference identifies operations that are undesirable, one of skill in the art would not be motivated to combine, and in fact would be discouraged from combining, those teachings with other references. Rather, when one reference discourages particular operations, as *Nguyen* does here, that reference teaches away from a combination. *See, e.g., In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Thus, Applicant respectfully submits that the combination is improper and fails to teach or suggest all elements of the claims.

Applicant thus respectfully submits that *Coile, Hasegawa, Nguyen*, and *Anabuki*, whether taken alone or in combination, fail to teach or suggest every element of Claim 1. Likewise, independent Claims 7, 11, and 16 include limitations that, for substantially similar reasons, are not taught or suggested by the references. Because *Coile, Hasegawa, Nguyen*, and *Anabuki*, whether taken alone or in combination, fail to teach or suggest every element of independent Claims 1, 7, 11, and 16, Applicant respectfully requests reconsideration and allowance of Claims 1, 7, 11, and 16, and their respective dependent claims.

B.   There is no suggestion or motivation in the cited references or in the prior art to combine *Coile, Hasegawa, Nguyen*, and *Anabuki*.

As previously argued by Applicant, the proposed combination of *Coile, Hasegawa, Nguyen*, and *Anabuki* is improper because the prior art fails to suggest or motivate the proposed combinations of the references. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

Nothing in *Coile, Hasegawa, Nguyen*, or *Anabuki* suggests or motivates the proposed combination. *Coile* provides "a system and method supporting efficient distribution of file

access requests across one or more storage device systems." *Coile*, Abstract. *Hasegawa* provides an image processing apparatus that permits a user to view the effect of different combinations of parameters on a number of "peripheral" images related to a reference image. *See Hasegawa*, Col. 2, line 62 – Col. 3, line 8; Figure 9. *Nguyen* "discloses a system of software distribution in computer manufacturing which manages and distributes software from release by a software engineering group to installation at a remote manufacturing site or testing facility." *Nguyen*, Abstract. *Anabuki* provides "an image processing apparatus that receives input image data in the form of separated data, combines those data, and outputs the combined one." *Anabuki*, Col. 1, lines 5-9.

These disparate fields of endeavor highlight the dramatic differences between the teachings of each reference. The U.S. classifications and fields of search emphasize these differences. None of the four references have common U.S. classifications with each other. *Coile* is classified in 709: "ELECTRICAL COMPUTERS AND DIGITAL PROCESSING SYSTEMS: MULTICOMPUTER DATA TRANSFERRING;" *Hasegawa* in 345: "COMPUTER GRAPHICS PROCESSING AND SELECTIVE VISUAL DISPLAY SYSTEMS;" *Nguyen* in 707: "DATA PROCESSING: DATABASE AND FILE MANAGEMENT OR DATA STRUCTURES;" and *Anabuki* in 358: "FACSIMILE AND STATIC PRESENTATION PROCESSING."

Further, while *Coile* and *Nguyen* have minor overlap with respect to the indicated fields of search, neither *Hasegawa* nor *Anabuki* shares any overlapping fields of search with either *Coile*, *Nguyen*, or the other. In fact, the references for *Hasegawa's* fields of search are contained in a completely different search room at the Patent Office than for *Coile*, *Nguyen*, or *Anabuki*. Thus someone searching for references related to *Hasegawa* would be hard pressed to come across *Coile*, *Nguyen*, or *Anabuki*, and even more hard pressed to find a motivation to combine the references.

Applicant respectfully submits that the *Office Action* fails to demonstrate a sufficient suggestion or motivation to combine the references. For example, with regard to Claim 1, the *Office Action* states:

> It would have been obvious to one of ordinary skill in the art at
> the time the invention was made to combine Hasegawa with
> Coile because it would allow the user to easily check the
> characteristics of each image, and quickly grasp situations such
> as separated shape and size of the image on the contracted

image, therefore the user can efficiently retrieve and manipulate any image. [sic]

Office Action, p. 5. Then, the *Office Action* states:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Anabuki with the combine system of Coile, Hasegawa and Nguyen because utilizing an input and output portion allows the device to obtain image data form outside devices such as a communication network or facsimile machine, manipulate image data to the clients specification and output the newly manipulated image data to another device on the communication network such as a external storage device. [sic]

Id. at 6.

Applicant respectfully submits that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the *Office Action* has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the reference, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For these reasons the *Office Action* fails to present a *prima facie* case of obviousness. Thus, the proposed combination of *Coile, Hasegawa, Nguyen,* and *Anabuki* is improper. For at least this reason, Applicant respectfully submits that Claims 1-17 are allowable over the cited references and requests reconsideration and allowance of Claims 1-17.

CONCLUSION

Applicant has made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Kurt M. Pankratz, Attorney for Applicant, at the Examiner's convenience at (214) 953-6584.

Applicant believes no fees are due; however, the Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

Kurt M. Pankratz
Reg. No. 46,977

Date: May 24, 2006

Correspondence Address:

at Customer Number: **05073**